

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mark D. Ackerman et al. Examiner: Behrang Badii

Serial No.: 09/973,664 Group Art Unit: 3694

Filed: October 09, 2001 Docket: 1565.039US1

For: SYSTEM AND METHOD FOR CONTROLLING ACCESS TO LICENSED
COMPUTING PROCESSES VIA A CODIFIED ELECTRONIC LICENSE

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on March 13, 2008 and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on February 13, 2008, from the Final Rejection of claims 15-21 of the above-identified application, as set forth in the Final Office Action mailed on December 13, 2007.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$510.00 which represents the requisite fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, Novell, Inc. as evidenced by the assignment from the inventors to Volera, Inc. and recorded October 9, 2001 on Reel 012251, Frame 0955 and the assignment from Volera, Inc. to Novell, Inc. recorded July 21, 2003 and recorded on Reel 014293, Frame 0075.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on October 9, 2001 with claims 1-22. A Final Office Action (hereinafter “the Final Office Action”) was mailed August 10, 2005 rejecting claims 1-22. Claims 1-22 were appealed on March 13, 2006. The application was bounced out of appeal via an Examiner’s Restriction Requirement on October 11, 2006. On November 13, 2006 Applicant elected claims 15-22 for prosecution and cancelled, without prejudice claims 1-14. On February 8, 2007 a first action following the Restriction Requirement and Appeal attempt was levied in which claims 15-22 were rejected. A Final rejection was mailed December 13, 2007. Finally, an adverse decision on a Pre-Appeal Request for Review was received by the Appellant rejecting claims 15-22 on March 13, 2008. Claims 15-22 stand rejected.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated December 13, 2007.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Some aspects of the present inventive subject matter include, but are not limited to, systems, methods, and media for electronic licensing. Specifically, pending independent claim 15 appears as follows with support for the limitations by reference to page and line numbers in the original filed specification:

INDEPENDENT CLAIM 15

15. A method for licensing external processes on a server comprising the steps of: **[FIG. 7 and page 19 beginning at line 1 and continuing to page 20 line 12]**

generating an electronic license, wherein the electronic license is generated by formatting a customer order for a software product in accordance with a licensing schema and the formatted electronic license to include a plurality of software command directives embedded within the formatted electronic license to indicate whether a particular software command directive associated with a particular feature of the software product is to be accepted for registration or rejected for registration, **[FIG. 5, block 520 and page 17 lines 3-12; and FIG. 4]** and wherein each software command directive includes a command name associated with a particular software command or operation of the software product and an inclusion or exclusion identifier for indicating the acceptance or rejection of registration for that particular software command or operation within the software product, and wherein at least one software command for the software product is associated with the exclusion identifier **[Page 15 lines 27-32 and page 16 lines 7-21]**; and

registering selective ones of the software commands in response to the software command directives and their inclusion and exclusion identifiers **[Page 19 lines 20-23; FIG. 7 item number 750; FIG. 6 item number 680; FIG. 4 item number 470]**; and

executing the registered commands **[FIG. 7 block 760 and page 19 line 20 continuing to page 20 line 1]**.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 15-21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Claims 15-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Biddle et al. (U.S. 2002/0107809) in view of Clement et al. (U.S. 7,203,703).

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §112 second paragraph

In rejecting a claim under the second paragraph of 35 U.S.C. § 112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. Ex parte Wu, 10 U.S.P.Q.2d 2031, 2033 (B.P.A.I. 1989) (citing In re Moore, 439 F.2d 1232, 169 U.S.P.Q. 236 (C.C.P.A. 1971); In re Hammack, 427 F.2d 1378, 166 U.S.P.Q. 204 (C.C.P.A. 1970)).

The M.P.E.P. adopts this line of reasoning:

whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the whole claim to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.

M.P.E.P. § 2173.02 (emphasis added).

Moreover, if the language is as precise as the subject matter permits, the courts can demand no more. Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985), cert. dismissed, 474 U.S. 976 (1985) (quoting Georgia-Pacific Corp. v. United States Plywood Corp., 258 F.2d 124, 136, 118 U.S.P.Q. 122, 132 (2d Cir.), cert. denied, 358 U.S. 884, 119 U.S.P.Q. 501 (1958)).

B) The Applicable Law under 35 U.S.C. §103(a)

In rejecting a claim under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459,

467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ ... [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the interferences and creative steps that a person ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

C) Discussion of the rejection of claim 15 under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particular point out and distinctly claim the subject matter of the invention.

The Examiner’s position is that the Applicant is trying to claim a license customizing schema. The Examiner states this is a guess and then asks: does the software come with the license; does the user tell the maker what to make; is the user involved; and what is the purpose of the inclusion and exclusion identifier? The Examiner also states that the claim is generally vague.

MPEP 2172 requires that for a rejection under the second paragraph the Examiner must indicate that the Applicant has stated the invention is something else someone in the original filed specification from that which is declared in the claims. The Examiner has not done this, the Examiner did not state that the specification says X and the claims say Y. All the Examiner has done, is state that it appears the applicant is trying to claim a licensing schema. Even assuming this were the case, the Examiner does not indicate why that is problematic with the specification as drafted. In the original filed specification at page 9 lines 9-19; and page 17 lines 5-12, Applicant clearly defined usage of a specific type of schema, namely an XML schema for purposes of formatting a customer order for a software product, the schema is used to format and organize the license information for the order. This is not ambiguous on its face with claim 15 as drafted and the Examiner has provided no indication as to how it is. Why is it problematic that

Applicant claimed a licensing customizing schema? Why does this render the claims indefinite in view of the original filed specification? The Examiner has provided the Applicant no guidance whatsoever on these issues. The Examiner concludes it is problematic but then provides no rationale as to why it is problematic. Applicant provided the amendment for purposes of specifically detailing a technique for generating the license, this did not create ambiguity it in fact added definiteness to the claims.

Applicant asserts that one of ordinary skill in the art having read claim 15 would not view it as indefinite in view of the original filed specification. In fact, it would be viewed more definite than the original claims as drafted.

Moreover, the claim on its face answers the Examiner's questions with no ambiguity. Specifically, the Examiner asks does the software product come with the license. The claim itself indicates that the license is generated by formatting a customer order for a software product. The last limitation indicates that the registered commands are executed for the software product. The question as to whether the software product comes with the license is irrelevant and would be to one of ordinary skill in the art because the license dictates what commands the customer can execute and the method drives the processing of those commands. It is inconsequential as to whether the license is in the product or associated with the product. This question asked by the Examiner has absolutely no bearing on the claim and its interpretation and one of ordinary skill in the art would feel the same way.

The next question the Examiner asks is whether the user tells the software maker what to make. The claim specifically states a license is generated in response to a customer order for a software product. So, yes actions taking by a customer to product a customer order for a software product tells the method what license needs generated. This fact is unambiguous and clear in the claim. Once again Applicant fails to see any ambiguity in the claim as drafted that would prevent this question from being answered in a definitive manner. Moreover, Applicant is still unsure as to what bearing this question even has on the claim as a whole.

Finally, the Examiner asks: what is the purpose of the exclusion and inclusion identifiers? The claim specifically states that particular commands of the software product are registered and that at least one command is associated with an exclusion. The claim states that inclusion is a

command that is accepted for registration and exclusion is one that is rejected for registration. Just the registered commands are executed. So, it is abundantly clear that the inclusion identifier identifies registered commands that can be processed with the software product and the exclusion identifier represents commands of the software product that are not registered and therefore not capable of being processed. Again, Applicant fails to see how there is any ambiguity at all in this and fails to see how one of ordinary skill in the art would view this as ambiguous.

The claim as drafted does not conflict in language or in interpretation with the original filed specification. The questions asked by the Examiner fail to tell the Applicant why they are significant in this analysis and why in the absence of answers to these questions that the claims are indefinite. Moreover, the questions are clearly and unambiguously answered by the original claim language of the claim.

Thus, this rejection is entirely inappropriate and has failed to provide adequate notice under the administrative procedure act to the Applicant, such that it could even be answered and addressed in a manner that the Examiner wanted. Applicant cannot guess as to why the claim is “generally vague” as the Examiner also stated in the Final Rejection. For all these reasons the Applicant respectfully requests that the 112 rejections be withdrawn.

D) Discussion of the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Biddle et al. (U.S. 2002/0107809 herein after “Biddle”) in view of Clement et al. (U.S. 7,203,703 herein after “Clement”).

Claim 15 was rejected as being unpatentable over Biddle in view of Clement.

The Examiner has never provided any reference in support of his contention that exclusion identifiers were well known in the art as of the file date of this application. Moreover, the exclusion identifiers are specifically related to commands of a software product. This fact is clearly enumerated in the claims and cannot be overlooked. Therefore, Applicant does not believe the Examiner has adequate support to allege that exclusion identifiers for software commands in a software license are something that was well known in the art as of the file date

of this application. Correspondingly, unless and until the Examiner can supply support for this contention the rejections based on this Examiner assumption is inappropriate and should be withdrawn. Applicant respectfully requests an indication of the same.

Secondly, the Examiner has cited Clement (column 9 lines 50-54) to reject the exclusion usage. This reference deals with a search string and a Boolean operator “AND NOT” to exclude things from search results. This is not obvious in view of including identifiers (not Boolean operators) for purposes of selectively excluding command operations (not search data). Applicant does not believe the analogy is even close and does not believe that one of ordinary skill in the art would feel that it was close. Interpreting a Boolean operator for retrieval of data from a database would not be related in any common sense manner to those of ordinary skill in the art with identifiers in a license that excludes selective commands from a software product from being registered and thereby executed.

Even with the more relaxed laws on obviousness, the rationale supplied must comport with common sense as known to one of ordinary skill in the art. Applicant asserts that in this case the rationale defies common sense and cannot be made with a good faith manner.

Accordingly, Applicant respectfully requests that once and for all these rejections be withdrawn and the claims of record be allowed, as the prosecution history and rejections to date are in the respectful opinion of the Applicant bordering on being patently unfair and ludicrous at this point in time.

SUMMARY

It is respectfully submitted that the art cited does not render the claim 15 obvious and that the claims are not indefinite as drafted. Reversal of the rejection and allowance of the pending claim 15 and its dependents are respectfully requested.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.

P.O. Box 2938

Minneapolis, MN 55402

Date April 14, 2008

By: /



Joseph P. Mehrle

Reg. No. 45,535

8. CLAIMS APPENDIX

1-14 (Cancelled).

15. A method for licensing external processes on a server comprising the steps of:

generating an electronic license, wherein the electronic license is generated by formatting a customer order for a software product in accordance with a licensing schema and the formatted electronic license to include a plurality of software command directives embedded within the formatted electronic license to indicate whether a particular software command directive associated with a particular feature of the software product is to be accepted for registration or rejected for registration, and wherein each software command directive includes a command name associated with a particular software command or operation of the software product and an inclusion or exclusion identifier for indicating the acceptance or rejection of registration for that particular software command or operation within the software product, and wherein at least one software command for the software product is associated with the exclusion identifier; and

registering selective ones of the software commands in response to the software command directives and their inclusion and exclusion identifiers; and

executing the registered commands.

16. The method as set forth in claim 15 wherein the step of includes directing the software product to only use a set of licensed hardware resources, the set of licensed hardware resources also being defined by one or more fields in the electronic license.

17. The method as set forth in claim 15 wherein the step of generating includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses.

18. The method as set forth in claim 15 wherein the step of generating includes generating a

license upgrade, the license upgrade describing additional hardware resources licensed for use by the software product that are not part of hardware resources licensed for use by prior licenses.

19. The method as set forth in claim 15 wherein the step of generating includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the software product that add further capabilities to hardware resources licensed for use by prior licenses.

20. The method as set forth in claim 15 further comprising either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user.

21. The method as set forth in claim 15 further comprising installing the electronic license in the server in a over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server.

9. EVIDENCE APPENDIX

None.

10. Related Proceedings Appendix

None.